DRAWING AMENDMENTS:

The attached sheet of drawings includes changes to FIG. 2 correcting various informalities. No new matter has been added. The sheet, which includes FIG. 2, replaces the original sheet including FIG. 2.

The changes made in FIG. 2 are listed below:

FIG. 2:   In element 66, the text is amended as follows: "Recognize [[R]]request [[T]]to prepare message." Additionally, the flowchart line between element 74 and element 76 is lengthened to meet element 74.

REMARKS

Claims 5-7, 9-10, 12, 15, 18-19, and 21-22 are canceled without prejudice or disclaimer. Claims 1, 8, 11, 13-14, 16-17, and 20 have been amended. New claims 23-31 have been added. No new matter has been added. Claims 1-4, 8, 11, 13-14, 16-17, 20, and 23-31 are pending in the application.

Amendments to the Specification

Paragraph [0021] of U.S. Patent Publication No. 2005/0068939 has been amended to correct typographical errors. No new matter has been added.

Amendments to the Drawings

FIG. 2 has been amended to correct various informalities. No new matter has been added.

Claims 1-4 and 8 are Allowable

The Office has rejected claims 1-8, at paragraphs 7-9 of the Office Action, under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent Application No. 2004/0119761 ("Grossman") in view of "Special Edition Using Microsoft Outlook 2000" ("Padwick"), in view of U.S. Patent No. 7,315,613 ("Kleindienst"), in view of U.S. Patent Application No. 2003/0098892 ("Hiipakka"), and in further view of U.S. Patent No. 6,014,135 ("Fernandes"). Claims 5-7 have been canceled without prejudice or disclaimer. Applicants respectfully traverse the remaining rejections.

The cited portions of Grossman, Padwick, Kleindienst, Hiipakka, and Fernandes, individually or in combination, do not disclose or suggest the specific combination of claim 1. For example, the cited portions of Grossman, Padwick, Kleindienst, Hiipakka, and Fernandes, individually or in combination, fail to disclose or suggest a messaging system operable to automatically, without user interaction, convert a first file attached to an outgoing electronic message, the first file having a first file format, to produce a second file having a second file format, and automatically attach the second file to the outgoing electronic message, as in claim 1.

The Office admits, at page 5 of the Office Action, that Grossman, Padwick, Kleindienst, and Hiipakka do not specifically show an attachment engine operable to determine a type of a

device associated with at least one of multiple user-selected addresses and to automatically, without user interaction, <u>convert a file attached to an outgoing electronic message into a format receivable by the device</u>. (Emphasis added).

Fernandes describes that a user can create a document and send the document to another individual. *See* Fernandes, col. 10, line 50-col. 11, line 4. Fernandes describes that a document sent to another person is automatically converted to a format acceptable by the other person. *See* Fernandes, col. 11, lines 7-27. The cited portions of Fernandes fail to disclose or suggest <u>an attached file</u>. The cited portions of Fernandes fail to disclose or suggest a messaging system operable to automatically <u>convert a first attached file</u> (attached to an outgoing electronic message) to <u>produce a second file</u>. The cited portions of Fernandes fail to disclose or suggest <u>automatically attaching a second file</u> (converted from a first attached file) to an outgoing electronic message. The cited portions of Fernandes fail to disclose or suggest <u>attaching a first file and a second file (converted from the first file) to an outgoing electronic message</u>. The cited portions of Fernandes do not disclose or suggest a messaging system operable to automatically, without user interaction, convert a first file attached to an outgoing electronic message, the first file having a first file format, to produce a second file having a second file format, and automatically attach the second file to the outgoing electronic message, as in claim 1.

Therefore, the cited portions of Grossman, Padwick, Kleindienst, Hiipakka, and Fernandes, individually or in combination, fail to disclose or suggest at least one element of claim 1. Hence, claim 1 is allowable. Claims 2-4 and 8 are allowable at least by virtue of their dependence from claim 1.

Claims 11, 13-14, 16-17, and 20 are Allowable

The Office has rejected claims 11, 13-14, 16-18, and 20-22, at paragraph 10 of the Office Action, under 35 U.S.C. § 103(a), as being unpatentable over Grossman in view of U.S. Published Application No. 2002/0160757 ("Shavit"), in view of Kleindienst, in view of Hiipakka, and further in view of Fernandes. (Applicants respectfully point out that Fernandes is not listed as a reference on page 7 of the Office Action, and that Fernandes is relied upon on pages 9-11 of the Office Action). Claims 18 and 21-22 have been canceled without prejudice or disclaimer. Applicants respectfully traverse the remaining rejections.

A. Claims 11, 13-14, and 16-17

The cited portions of Grossman, Shavit, Kleindienst, Hiipakka, and Fernandes, individually or in combination, do not disclose or suggest the specific combination of claim 11. For example, the cited portions of Grossman, Shavit, Kleindienst, Hiipakka, and Fernandes, individually or in combination, fail to disclose or suggest automatically converting a first file (having an initial format and attached to an outgoing message) to produce a second file having a different format, where the different format differs from the initial format (of the first file), and attaching the second file to the outgoing electronic message, as in claim 11.

The Office admits, at page 5 of the Office Action, that Grossman, Kleindienst, and Hiipakka do not specifically show an attachment engine operable to determine a type of a device associated with at least one of multiple user-selected addresses and to automatically, without user interaction, <u>convert a file attached to an outgoing electronic message into a format receivable by the device</u>. (Emphasis added).

Shavit describes that a sender may compose a message in various formats and, if necessary, the message is converted to another format. *See* Shavit, paras. [0024]-[0031]. Shavit describes that a converted message may be sent as an e-mail attachment. *See* Shavit, paras. [0032], [0057]-[0058], and [0066]. Shavit describes that a composed e-mail message having an attachment may be delivered by IM with a URL to an attachment file included in the IM or by SMS by converting formatted text into unformatted text and including only an attachment name rather than the attachment file itself. *See* Shavit, paras. [0027] and [0061]-[0062]. The cited portions of Shavit fail to disclose or suggest automatically <u>converting a first attached file</u> (attached to an outgoing electronic message) to <u>produce a second file having a different format than the format of the first file</u>. The cited portions of Shavit fail to disclose or suggest <u>attaching both a first file (having an initial format) and a second file (converted from the first file) to an outgoing electronic message</u>. Hence, the cited portions of Grossman, Kleindienst, Hiipakka, and Shavit fail to disclose or suggest automatically converting a first file (having an initial format and attached to an outgoing message) to produce a second file having a different format, where the different format differs from the initial format (of the first file), and attaching the second file to the outgoing electronic message, as in claim 11.

Fernandes describes that a user can create a document and send the document to another individual. *See* Fernandes, col. 10, line 50-col. 11, line 4. Fernandes describes that a document sent to another person is automatically converted to a format acceptable by the other person. *See* Fernandes, col. 11, lines 7-27. The cited portions of Fernandes fail to disclose or suggest <u>attaching a second file (converted from a first file) to an outgoing electronic message</u>. The cited portions of Grossman, Shavit, Kleindienst, Hiipakka, and Fernandes fail to disclose or suggest automatically converting a first file (having an initial format and attached to an outgoing message) to produce a second file having a different format, where the different format differs from the initial format (of the first file), and attaching the second file to the outgoing electronic message, as in claim 11.

Thus, the cited portions of Grossman, Shavit, Kleindienst, Hiipakka, and Fernandes, individually or in combination, fail to disclose or suggest at least one element of claim 11. Hence, claim 11 is allowable. Claims 13-14 and 16-17 are allowable at least by virtue of their dependence from claim 11.

B. Claim 20

The cited portions of Grossman, Shavit, Kleindienst, Hiipakka, and Fernandes do not disclose or suggest the specific combination of claim 20. For example, the cited portions of Grossman, Shavit, Kleindienst, Hiipakka, and Fernandes, individually or in combination, fail to disclose or suggest a non-transitory machine-readable medium including machine-executable instructions that, when executed by a machine, cause the machine to automatically convert a first file (having an initial format and attached to an outgoing electronic message) to produce a second file, the second file having a different format that differs from the initial format (of the first file), and attach the second file to the outgoing electronic message, as in claim 20.

The Office admits, at page 5 of the Office Action, that Grossman, Kleindienst, and Hiipakka do not specifically show an attachment engine operable to determine a type of a device associated with at least one of multiple user-selected addresses and to automatically, without user interaction, <u>convert a file attached to an outgoing electronic message into a format receivable by the device</u>. (Emphasis added).

Shavit describes that a sender may compose a message in various formats and, if necessary, the message is converted to another format. *See* Shavit, paras. [0024]-[0031]. Shavit describes that a converted message may be sent as an e-mail attachment. *See* Shavit, paras. [0032], [0057]-[0058], and [0066]. Shavit describes that a composed e-mail message having an attachment may be delivered by IM with a URL to an attachment file included in the IM or by SMS by converting formatted text into unformatted text and including only an attachment name rather than the attachment file itself. *See* Shavit, paras. [0027] and [0061]-[0062]. The cited portions of Shavit fail to disclose or suggest automatically <u>converting a first attached file</u> (attached to an outgoing electronic message) to <u>produce a second file</u>. The cited portions of Shavit fail to disclose or suggest <u>attaching both a first file and a second file (converted from the first file) to an outgoing electronic message</u>. Hence, the cited portions of Grossman, Kleindienst, Hiipakka, and Shavit fail to disclose or suggest a non-transitory machine-readable medium including machine-executable instructions that, when executed by a machine, cause the machine to automatically convert a first file (having an initial format and attached to an outgoing electronic message) to produce a second file, the second file having a different format that differs from the initial format (of the first file), and attach the second file to the outgoing electronic message, as in claim 20.

Fernandes describes that a user can create a document and send the document to another individual. *See* Fernandes, col. 10, line 50-col. 11, line 4. Fernandes describes that a document sent to another person is automatically converted to a format acceptable by the other person. *See* Fernandes, col. 11, lines 7-27. The cited portions of Fernandes fail to disclose or suggest <u>attaching a first file (having an initial format) and a second file (converted from the first file) to an outgoing electronic message</u>. The cited portions of Grossman, Shavit, Kleindienst, Hiipakka, and Fernandes fail to disclose or suggest a non-transitory machine-readable medium including machine-executable instructions that, when executed by a machine, cause the machine to automatically convert a first file (having an initial format and attached to an outgoing electronic message) to produce a second file, the second file having a different format that differs from the initial format (of the first file), and attach the second file to the outgoing electronic message, as in claim 20.

Therefore, the cited portions of Grossman, Shavit, Kleindienst, Hiipakka, and Fernandes, individually or in combination, fail to disclose or suggest at least one element of claim 20. Hence, claim 20 is allowable.

Claims 23-31 are Allowable

New claims 23-31 have been added and are supported by the specification. No new matter has been added.

Claims 23-24 depend from claim 1, which Applicants have shown to be allowable. Therefore, claims 23-24 are allowable at least by virtue of their dependence from claim 1. Claims 25-28 depend from claim 11, which Applicants have shown to be allowable. Therefore, claims 25-28 are allowable at least by virtue of their dependence from claim 11. Claims 29-31 depend from claim 20, which Applicants have shown to be allowable. Therefore, claims 29-31 are allowable at least by virtue of their dependence from claim 20.

Further, the cited portions of the above cited references fail to disclose or suggest displaying a first indicator indicating that a first file is attached to an outgoing electronic message and concurrently displaying a second indicator indicating that a second file is attached to the outgoing electronic message, as in claims 24, 28, and 31. For this additional reason, claims 24, 28, and 31 are allowable.

<div align="center">

CONCLUSION

</div>

Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the cited portions of the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the objections and rejections, as well as an indication of the allowability of each of the pending claims.
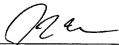
Any changes to the claims in this response, which have not been specifically noted to overcome a rejection based upon the cited references, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

_2010 - 10 - 01_
Date

Jason L. Moore, Reg. No. 52,046
Attorney for Applicants
Toler Law Group, Intellectual Properties
8500 Bluffstone Cove, Suite A201
Austin, TX 78759
Telephone: (512) 327-5515
Facsimile: (512) 327-5575